

Remarks:

Reconsideration of the application is respectfully requested.

Additionally, Applicants respectfully request that the finality of the present action be withdrawn. Applicants' representative has called Examiner Le several times to request such withdrawal. Examiner Le has asked Applicants' representative to make the request in writing, in the present response. As such, pursuant to Examiner Le's request, Applicants set forth the following facts in support of the withdrawal of the finality of the present Office Action.

1. The present Office Action offered a new ground for rejecting Applicants' claims, even though Applicants did not amend their claims in response to the previous Office Action nor file an IDS including the reference used in the new ground for rejection.

- On January 19, 2005, after the filing of an RCE in the present case, a non-final Office Action was mailed in the above-named case rejecting all of Applicants' claims under 35 U.S.C. § 103(a) over U. S. Patent No. 6,162,069 to Kubinec ("KUBINEC") in view of U. S. Patent No. 5,789,797 to Ikuta et al ("IKUTA").
- On March 3, 2005, Applicants filed a Response to the Office Action of January 19, 2005, traversing the rejection of the claims based on the combination of KUBINEC and IKUTA, and offering reasons for

patentability over the alleged combination.

Applicants' did not amend any claims in the Response of March 3, 2005. Additionally, Applicants' did not file any IDS listing the **IKUTA** reference. Rather, the **IKUTA** reference was provided on the Notice of References Cited form, PTO-892, provided with the Office Action of January 19, 2005.

- The present Office Action was mailed on May 17, 2005 ("final Office Action") "responsive to the communication(s) filed on 08 March 2005", and was made final. In the final Office Action, all claims were now rejected under 35 U.S.C. § 102(b) by **IKUTA** and under 35 U.S.C. § 103(a) over U. S. Patent No. 6,331,719 to Ooishi ("**OOISHI**") in view of **IKUTA**. The Office Action stated on page 2 "The rejection over Kubinec (US 6,192,069) is withdrawn in view of the amendments to the claim". **However, no amendments had been made to the claims.**
- The rejections of Applicants' claims, made in the final Office Action, both under 35 U.S.C. § 102(b) and **IKUTA** and 35 U.S.C. § 103(a) **OOISHI** in view of **IKUTA** were new grounds of rejection (i.e., in contrast to the previous 35 U.S.C. § 103(a) rejection which used **IKUTA** merely as a secondary reference) which were **neither : 1) necessitated by**

applicant's amendment of the claims (i.e., no amendments were made to the claims); nor 2) based on information submitted in an information disclosure statement (i.e., IKUTA and OOISHI were both introduced by the Examiner. Neither reference was provided by the Applicants in an IDS).

2. The finality of the present action is premature pursuant to MPEP § 706.07(a).

- MPEP § 706.07(a) states in relevant part:

"Under present practice, second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement** filed during the period set forth in 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17(p)." [emphasis added by Applicants]
- The final Office Action introduced two new grounds of rejection (35 U.S.C. § 102(b) based on IKUTA and 35 U.S.C. § 103(a) over OOISHI in view of IKUTA)
- The new grounds of rejection were not necessitated by Applicants' amendment of the claims, as no claims were amended in the Response to the previous Office Action.
- The new grounds of rejection were not based on information submitted in an information

disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17(p), as the **IKUTA** and **OOISHI** references were raised, and cited, by the Examiner.

- The **OOISHI** reference, cited as a primary reference in the final Office Action, had not previously been cited in the case.
- In view of the foregoing, the finality of the present action is **premature** under MPEP § 706.07(a).

3. The finality of the present action should be withdrawn, pursuant to MPEP § 706.07(a).

- MPEP § 706.07(d) states in relevant part:

"If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she **should** withdraw the finality of the rejection." [emphasis added by Applicants]
- Applicants believe that they have shown, above, how the present action being made final was premature under MPEP § 706.07(a).
- Applicants, pursuant to MPEP § 706.07(d), have requested by telephone, and are requesting herein reconsideration of the finality of the previous Office Action.

- As such, pursuant to MPEP § 706.07(d), it is believed that the finality of the previous Office Action should be withdrawn, and Applicants are requesting such action.

Further, claims 1 - 6, 8 and 10 - 17 are presently pending in the application. Claims 1 and 2 have been amended. It is believed that, with the withdrawal of the finality of the present **final Office Action** requested by Applicants, above, the amendments to the claims should be ordinarily entered.

On page 2 of the **final Office Action**, claim 2 was rejected as allegedly being indefinite under 35 U.S.C. § 112, second paragraph. More specifically, it was alleged in the Office Action that in claim 2, the recitation "lines" on line 3 was allegedly confusing, making it unclear if this is additional "lines" or further recitation of the previously claimed "lines" in claim 1. Claim 2 has been amended to provide proper antecedent basis for "lines".

It is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, second paragraph.

Further on page 2 of the **final Office Action**, claims 1 - 6, 8 and 10 - 17 were rejected under 35 U.S.C. § 102(b) as

allegedly being anticipated by U. S. Patent No. 5,789,797 to IKUTA. On page 4 of the final Office Action, claims 1 - 6, 8 and 10 - 17 were also rejected under 35 U.S.C. § 103(a) as allegedly being obvious over OOISHI in view of IKUTA.

Applicants respectfully traverse the above rejections, as applied to the amended claims.

More particularly, claim 1 has been amended to recite, among other limitations:

a radio-frequency (RF) filter device having first and second capacitors connected to said lines and being completely integrated in the integrated circuit for preventing and restricting a propagation of high-frequency interference signals through said lines, the integrated circuit being a microprocessor or microcontroller. [emphasis added by Applicants]

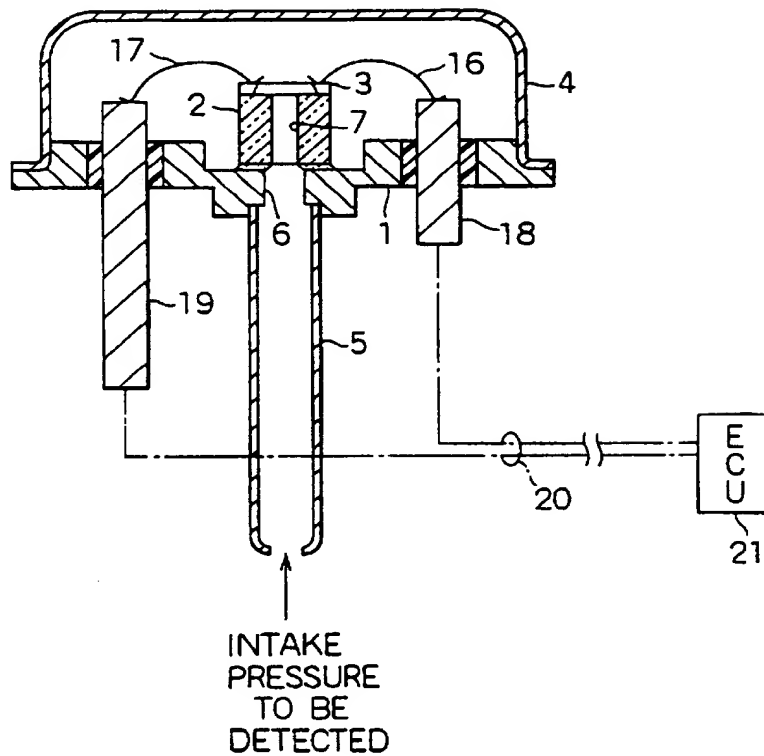
Thus, all of Applicants' claims require, among other limitations, the integrated circuit to be a microprocessor or microcontroller, and that the specifically recited RF filter device is completely integrated into the microprocessor or microcontroller. This amendment is supported by page 12 of the instant application, lines 7 - 10, which states:

The integrated circuit described in more detail below is an arbitrary integrated circuit, that is to say, by way of example, a microprocessor, a microcontroller, a memory module, or an arbitrary other integrated circuits. [emphasis added by Applicants]

The **IKUTA** reference neither teaches, nor suggests, integrating Applicants' particularly claimed RF filter device into a microprocessor or microcontroller, as presently claimed by Applicants. Rather, the **IKUTA** reference discloses a semiconductor device that suppresses electromagnetic noise provided for a sensor chip, only. See Abstract of **IKUTA**. And, although **IKUTA** teaches that the sensor chip containing the filter can be interfaced to a circuit containing an "Engine Control Unit" (**ECU** 21 of Fig. 2 of **IKUTA**) there is absolutely no teaching or suggestion in **IKUTA** of including such a filter device on the **ECU** control unit, or even of integrating the sensor chip of **IKUTA** with the **ECU** control unit of that reference. More particularly, Fig. 2 of **IKUTA** shows that the two devices are maintained as separate components. Fig. 2 of **IKUTA** is included herebelow, for convenience.



FIG. 2



That the sensor chip 3 and ECU control unit 21 of **IKUTA** are specifically designed to be separate is further supported in col. 4 of **IKUTA**, lines 19 - 39, which states:

As illustrated in FIG. 2, a power supply line, a ground line and an output line to the sensor chip 3 respectively are led out to the outside through bonding wires 16 and 17 and lead pins 18 and 19. The bonding wires 16 and 17 and the lead pins 18 and 19 are illustrated for two pieces respectively in FIG. 2. In actuality, however, the bonding wires and the lead pins are provided for three pieces respectively in correspondence to respective wiring.

Furthermore, the lead pins 18 and 19 are connected to an engine control unit (hereinafter referred to as "ECU") 21 through a wiring harness 20. The ECU 21 is constructed mainly of a microcomputer to detect the intake pressure by using signals from the sensor chip 3. Also, the ECU 21 detects the operational condition of the engine including the intake pressure, calculates fuel injection rate and ignition timing according to the operational condition of the engine, and controls the rate of fuel injection from an injector and the ignition timing. In FIG. 2, the injector, an igniter, etc. as actuator group components and an engine speed sensor, a water temperature sensor, an intake rate sensor, etc. as sensor group components are not illustrated.
[emphasis added by Applicants]

Note that Fig. 17 of IKUTA includes in the sensor chip 3 a block entitled "processing circuit". However this "processing circuit" of fig. 17 of IKUTA is a combination of the first circuit 9 and the second circuit 10 of Figs. 1 and 4 of IKUTA, and does not reference a microprocessor or microcontroller, as claimed by Applicants.

Because, among other reasons, the IKUTA reference neither teaches, nor suggests, Applicants' particular RF filter device integrated into a microprocessor or microcontroller, as recited in claim 1 of the instant application, Applicants' amended claims are believed to be patentable over the IKUTA reference cited in the final Office Action.

Nor does the OOISHI reference, cited in the Office Action cure the deficiencies of the IKUTA reference cited above. Rather,

OOISHI discloses a semiconductor device for reducing effects of noise upon a circuit in a semiconductor device. Like IKUTA, OOISHI fails to teach or suggest Applicants' particularly claimed filter circuit being integrated in a microprocessor or microcontroller, as presently claimed by Applicants. Col. 30 of OOISHI, lines 31 - 34, in fact, teaches that the semiconductor device of OOISHI, is a memory device. See also, col. 18 of OOISHI, lines 37 - 45; col. 21 of OOISHI, lines 63 - 63. OOISHI, read in combination with IKUTA (which discloses a filter being used on a sensor circuit, separate from a control unit), would teach away from Applicants' particularly claimed filter integrated with a microcomputer or microcontroller.

It is accordingly believed that none of the references, whether taken alone or in any combination, teach or suggest the features of claim 1. Claim 1 is, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1.

In view of the foregoing, reconsideration and allowance of claims 1 - 6, 8 and 10 - 17 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out. In the alternative, if, somehow, the finality of the **final Office Action** is not withdrawn, then the entry of the amendment is requested, as it is believed to place the application in better condition for appeal, without requiring extension of the field of search.

Additionally, please consider the present as a petition for a one (1) month extension of time, and please provide a one (1) month extension of time, to and including, September 17, 2005 to respond to the present Office Action.

The extension fee for response within a period of one (1) month pursuant to Section 1.136(a) in the amount of \$120.00 in accordance with Section 1.17 is enclosed herewith.

Please provide any additional extensions of time that may be necessary and charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



For Applicants

Kerry P. Sisselman
Reg. No. 37,237

September 19, 2005

Lerner and Greenberg, P.A.
Post Office Box 2480
Hollywood, FL 33022-2480
Tel: (954) 925-1100
Fax: (954) 925-1101